

REMARKS

We note with appreciation the Examiner's withdrawal of the previous rejection under 35 USC 112.

The current status of the claims is:

Claims 1-7, 17-22 stand rejected under 35 USC 101.

Claims 1-2, 5-6, 8, 11-15, 17, 19-21, 23, and 26-28 stand rejected under 35 USC 102(b) over the Hoffman reference.

Claims 3-5, 9-10, 16, 18, 24-25, and 29 stand rejected under 35 USC 103(a) over the Hoffman reference.

Turning first to matters of form, the Examiner has maintained the prior objection to the Specification, citing MPEP Section 608.01(b). We respectfully note that MPEP Section 608.01(b) provides guidance on the proper form for the Abstract and does not discuss the reference to URLs or hyperlinks in the disclosure. As respectfully noted in the previously filed response, the inclusion of information in the Specification that is within the public domain is not contrary to the Patent Rules, and nor is the reference to URLs (or hyperlinks). Nevertheless, the Specification has been amended as to form in accordance with the Examiner's request. No new matter has been added. Withdraw of the objection is therefore respectfully requested.

The Examiner has now also rejected Claims 1-7 and 17-22 under 35 USC 101. We respectfully traverse this rejection and submit that the solicited claims are, in fact, statutory subject matter within the purview of 35 USC 101.

The Examiner's rejection is based upon the contention that the claimed invention is not one of the laundry list of items cited by the Examiner, that no practical application in the technical arts is found, and that the claims therefore recite a non-statutory process.

We respectfully disagree.

Claims 1 and 17 expressly recite a method of electronically reallocating a portion of a transaction amount, which method expressly contains the steps of maintaining the recited accounts and electronically distributing/receiving at least of portion of the transaction amount to/in the recited accounts. This is expressly provided for in the solicited claims.

The claims clearly provide a practical application and are, in fact, a statutorily protectable process in that electronically moving funds from a transaction from one location to another for placement into an investment vehicle is clearly a practical application. In this regard, we respectfully note that it is wholly irrelevant that the claims do not expressly limit this practical process to a specific computer program, steps to be performed by a computer, a post-computer process activity or a pre-computer process activity (although these all clearly fall within the scope of the claims, as essentially acknowledged by the Examiner).

Section 101 provides that "Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title." 35 USC 101. Section 101, as interpreted by the U.S. Supreme Court, The Court of Appeals for the Federal Circuit, and the U.S. Patent Office do not require that a process be implemented by a computer in order to fall within the scope of 35 USC 101.

For example, we respectfully refer the Examiner to the Patent Office's own training materials on "business method" patents, a copy of which is enclosed for the Examiner's convenience. As expressly noted in these training materials, as long as the claimed process produces a useful, concrete, and tangible result, the claimed process satisfies the requirements of 35 U.S.C. 101. See slide number 9 of the enclosed Patent Office training materials. The claims need not recite any specific computer requirements.

It cannot be disputed that the recited claims provide a concrete and tangible result, e.g., the electronic movement of at least a portion of a transaction amount from one account to another to be placed in an investment vehicle. It is irrelevant whether this is accomplished using a computer or even the human mind. We respectfully request that Examiner carefully review the Patent Office training materials enclosed with this response.

Because the requirements of 35 USC 101 are satisfied by the solicited claims, we respectfully request that the rejection under 35 USC 101 be withdrawn.

We also again respectfully submit that the solicited claims are not anticipated by or obvious in light of the Hoffman (U.S. Patent No. 5,297,026) reference. Hoffman discloses a system for promoting accounting activity and providing a high rate of return for funds invested by the customer. Hoffman specifically requires that the funds to be invested are separate from

the funds paid by the customer for a given purchase or transaction (Col. 2, lines 3-12; Co. 4, lines 30-54; Figure 1 and Col. 5, lines 42-54; Figure 2).

In the system disclosed in Hoffman, the offering entity documents all of the purchases made by the customer in a given time period and allows the customer to separately remit a percentage of the total amount separately paid for the purchases to be placed in an investment account.

This is not the instant invention as specifically recited in the solicited claims.

In sharp contrast to Hoffman, in the claimed invention, at least a portion of the transaction amount is distributed to a trust account / investment vehicle. This is specifically recited in the claims and may not be ignored in comparing the claims of the instant application to the Hoffman reference.

Hoffman clearly requires that the customer submit a separate amount and it is this amount that is placed in the investment account. Thus, in Hoffman, no portion of the transaction amount is ever distributed to the trust account / investment vehicle. While the separate amount provided by the customer in Hoffman is capped as a percentage of the total amount of the purchases made in a given period, it is still a separate remittance and is not any portion of the transaction amount, as expressly recited in the claimed invention.

In continuing his rejection, the Examiner has not addressed this clear, express distinction recited in the claims over the cited reference, which precludes a rejection under 35 USC 102.

Moreover, it is well established that in order to maintain a rejection under 35 U.S.C. 103, there must be some motivation in the reference to suggest the modification. See MPEP 2143. As expressly stated by the Court of Appeals for the Federal Circuit in In re Mills, 16 USPQ2d 1430 (Fed. Cir. 1990):

"Although a prior art device 'may be capable of being modified to run the way [the patent applicant's] apparatus is claimed, there must be a suggestion or motivation in the reference to do so.' Id.

The teaching or suggestion to make the claimed modification and the reasonable expectation of success must both be found in the prior art, not in Applicant's disclosure. See MPEP 2143; In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Hoffman nowhere teaches or suggests modifying his system along the lines of the specifically claimed invention to transfer a portion of the transaction amount, nor provides any motivation for one of ordinary skill in the art to do so. This is further evident from the fact that the system disclosed in Hoffman operates in a completely different manner than the claimed invention.

For example, Hoffman provides a review of one or more purchases over a given period of time, and it then calculates a percentage up to which the customer may afterwards contribute separately to an investment account. In sharp contrast, in the claimed invention, a portion of a transaction amount may be electronically distributed to the trust account / investment vehicle; the customer does not have to separately transfer funds.

This allows the system of the instant invention to operate, for example, invisibly at a retail level. A user may use their credit card at a gas station or store, for example, and a portion of the transaction amount may be automatically transferred to the investment vehicle. This is not possible with the system disclosed in Hoffman and is nowhere suggested therein.

In continuing his rejection, the Examiner has not addressed the clear lack of any teaching or suggestion in the Hoffman reference to modify it along the lines of the claimed invention, given that the Hoffman system operates in a completely different manner than the invention as specifically recited in the solicited claims. Absent some teaching or suggestion in Hoffman for modifying the Hoffman system to transfer a portion of the transaction amount, as recited in the solicited claims, a rejection under 35 USC 103 cannot stand.

Accordingly, we respectfully request that the rejections under 35 USC 102(b) and 103(a) be withdrawn.

For the reasons set forth above, we respectfully submit that the solicited claims are now in proper condition for prompt allowance, which action is respectfully requested.

Respectfully submitted,

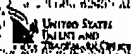


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35 U.S.C. 101 Training Materials

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35 U.S.C. Section 101 reads:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Translation:

35 U.S.C. 101 defines statutory subject matter as "any new and useful process, machine, manufacture or composition of matter, or any new and useful improvement thereto."

Anything Under the Sun

The Supreme Court acknowledged that Congress, through legislative history, intended statutory subject matter to "include anything under the sun that is made by man." See *Diamond v. Chakrabarty*, 447 U.S. 303, 309, 206 USPQ 193, 197 (1980).

Exceptions

Despite the apparent sweep of Section 101, the Supreme Court has specifically identified three categories of nonstatutory subject matter:

- laws of nature
- natural phenomena, and
- abstract ideas

These are not categories of invention. See *Diamond v. Diehr*, 450 U.S. at 175, 209 USPQ 1 (1981).

Mathematical Algorithms *per se*

Mathematical algorithms *per se* that stand alone and are not reduced to a practical application represent nothing more than an abstract idea.

From Abstract Idea to Patentable Subject Matter

Practical Application

When an abstract idea is reduced to a practical application, the abstract idea no longer stands alone if...

Useful, Concrete and Tangible

the practical application of the abstract idea produces a **useful, concrete and tangible result**. This then satisfies the requirements of 35 U.S.C. 101. *In re Alappat*, 31 USPQ2d 1945, 1558 (Fed. Cir. 1994); *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 17 USPQ2d 1596, 1601-02 (Fed. Cir. 1998).

State Street Bank & Trust Co. v. Signature Financial Group Inc.

The Invention

The patent claims recite a data processing system for implementing a hub and spoke investment structure to maximize return on investment while minimizing tax liability. The system transforms data, representing discrete dollar amounts, into a final share price using a machine (computer) that makes a series of mathematical calculations.

State Street - The Bottom Line

The courts held that a machine (computer)

More on State Street

A process, machine, manufacture, or